

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences**

In re Patent Application of

SHIMIZU

Atty. Ref.: 723-1464

Serial No. 10/763,159

TC/A.U.: 3714

Filed: January 26, 2004

Examiner: A. Hall

For: GAME APPARATUS, GAME SYSTEM, AND STORING MEDIUM
STORING GAME PROGRAM IN WHICH DISPLAY IS DIVIDED
BETWEEN PLAYERS

* * * * *

August 5, 2009

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

In response to the Examiner's Answer dated June 5, 2009, Applicant now submits
the following Reply Brief pursuant to 37 C.F.R. § 41.41.

REMARKS/REPLY-ARGUMENT

This is in response to the Examiner's Answer dated June 5, 2009. The arguments set forth in the Appeal Brief dated February 5, 2009 are incorporated herein by reference, and Applicant will not repeat the same herein. The following arguments are presented in response to the new arguments presented in the Examiner's Answer (e.g., see the "Response to Arguments" section on pages 9-12 of the Examiner's Answer) and also further clarify Applicant's previous positions.

As shown in detail below, the Examiner's Answer relies on dubious premises, numerous "logical leaps," and incredible readings of the prior art (and Suzuki, in particular) in an effort to find the "evaluating value setting programmed logic circuitry for setting an evaluating value of each player based on how well each player is doing in the game relative to the other players" and "size changing programmed logic circuitry for changing a size of said divided areas allotted to each player based on said evaluating value," recitations of claim 1, and the similar features of the other independent claims. The Final Rejection should therefore be reversed for at least these reasons.

The Examiner's Answer notes that Applicant did not necessarily disagree with the assertion that the limitation of "how well each player is doing in the game relative to the other players" can be interpreted to be a measure of relative advantage of a player over another. The Examiner's Answer further notes that Applicant did not necessarily find unreasonable the assertion that an attacking or offensive player may be said to be "doing better than" the attacked or defensive player. However, in the course of engaging in this

“cherry picking” exercise, the Examiner’s Answer glosses over the fact (1) these mere allegations are wholly unsupported by any actual, objective teaching present in the record, and (2) there is equally valid “commonsense” that argues that a player with a good defense may be said to be “doing better than” an attacking player. Accordingly, the Examiner’s Answer has failed to address the fact that the fundamental assumptions upon which the Final Rejection relies are seriously flawed.

In addition to failing to address the flaws in the assumptions upon which the Examiner is relying, the Examiner’s Answer continues to make the “logic leap” that, from the two unsupported allegations noted above, Suzuki somehow “teaches that a decision is made as to whether a player in a offensive position has an advantage over a player in a defensive position in that it is attacking the defensive player so as to affect the enlargement of a background picture. . . .” These two facts alone do not lead to this conclusion. In other words, notwithstanding the flaws in the Examiner’s assumptions, if there are some intermediate “logical” steps that enable this conclusion to be reached, the Examiner’s Answer has failed to explain them, and Applicant have failed to divine them.

Perhaps more fundamentally, the “conclusion” that Suzuki enlarges a portion of a screen based on whether a player is attacking, simply stated, is erroneous. As shown in detail in the Appeal Brief, Suzuki teaches that the size of a portion of the screen is changed based solely upon the position of a moving object D. Whether a particular player is attacking or defending thus is irrelevant to any changes in the screen size in Suzuki, since the position of the moving object D exclusively determines whether the

portion of the screen is to be enlarged. In other words, an attacking or a depending player's portion of the screen is enlarged based on the position of the moving object D, thus teaching directly away from the invention as presently claimed.

The Examiner's Answer appears to admit that it is the position of the moving object D that determines whether a portion of the screen is to be enlarged. The Examiner's Answer nonetheless insists that there are "non-preferred" or "alternate" embodiments in Suzuki that support the ultimate conclusion of obviousness -- without ever identifying where they are or what they might be. Indeed, although the Examiner's Answer is correct in noting that Suzuki discloses additional embodiments, significantly, (1) the Examiner's Answer has now admitted that the Final Rejection depends on the third embodiment of Suzuki, and (2) none of the alternate embodiments support the Examiner's position. Moreover, a careful reading of the cited portions of Suzuki shows that the Examiner's position is without merit because it simply does not teach what the Examiner's Answer alleges it teaches. Accordingly, the Final Rejection should be reversed, at least because of the scope and content of the prior art has not been adequately resolved.

At the top of page 11, the Examiner asserts that there is "no legal error . . . since the above rejections take into account the prior art as a whole. . . ." However, as shown above, there are clear and obvious factual errors in the Examiner's positions. Additionally, there are clear and obvious legal errors because what matters when assessing the differences between the prior art and the claims under Section 103 (as

explained in MPEP 2141.02(I) and the related case law) is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Analyzing the “prior art as a whole” does not somehow cure the legal error in the statement that “each of the features of Applicant’s invention as presented in the claims are [sic] obvious of the prior art.” The Final Rejection thus is improper for this additional reason.

Finally, although the Examiner’s Answer attempts to make up for admitted deficiencies in the Oakes/Suzuki combination in the context of claims 6, 9-10, and 13-14, through citation to Sciammarella, the Examiner’s Answer misses the point that Sciammarella has absolutely nothing to do with the other applied references -- or the claimed invention. The citation to the “catch-all” statement in Sciammarella that it can be applied “in any environment or application in which a visual factor can be a useful measure of important categorical information” is of no avail given its seriously divergent subject matter. Sciammarella simply does not relate to video games. Nor do the other applied references “utiliz[e] scale and location to express the degree of importance of a particular category over other categories of categorical information with respect to a selected measurement value” as is required by Sciammarella.

Moreover, even if one of ordinary skill in the art at the time of the invention would have combined these three very different references, the resulting three-way Oakes/Suzuki/Sciammarella combination still would be deficient for failing to teach or suggest the features of these claims. That is, how well a player is doing relative to

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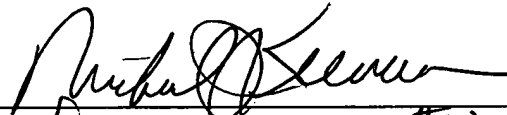
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another player does not constitute the type of "categorical information with respect to a selected measurement value" contemplated by Sciammarella. Sciammeralla, alone or in combination with Oakes and Suzuki, thus would not teach partitioning or re-partitioning areas of a screen based on how well a player is doing relative to another player. Thus, the rejection of these claims remains flawed.

The application is in clear condition for allowance, and early reversal of the Final Rejection and passage of the subject application to issue thus are earnestly solicited.

Respectfully submitted,

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